



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,935	11/15/2000	Ying Xie	80168-0126	5703
32658	7590	01/13/2005	EXAMINER	
HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEEN ST. DENVER, CO 80202			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/712,935	XIE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 November 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3,5-9,11,12 and 14 is/are pending in the application.  
 4a) Of the above claim(s) 4,15 and 20-23 is/are withdrawn from consideration.  
 5) Claim(s) 6 is/are allowed.  
 6) Claim(s) 1,3,5,7-9,11,12 and 14 is/are rejected.  
 7) Claim(s) 6 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicants' election without traverse of Group I (claims 1, 3-9, 11, 12, 14, and 20-23) on November 3, 2004 is acknowledged. In addition, in a telephonic interview on January 7, 2004, Attorney Kent Lembke selected the species of claims 3, 5-8, 11, and 14 for examination.

Claims 1, 3, 5-9, 11, 12, and 14 are pending and will be considered for examination. Claims 4, 15, and 20-23 are hereby withdrawn from consideration.

### ***Allowable Subject Matter***

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims make only nominal use of technology and are therefore not within the technological arts.

*The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665, 1671 (Bd. Pat. App. & Inter. 2001)).* Although Bowman is not precedential, it has been cited for its analysis. Bowman requires non-trivial recitation of technology in the body of the claim language. In the present case, claims 1, 3, and 5-8 do not recite any technology in the body of the claims. Indeed the steps of receiving, sorting, and determining can be performed by hand and do not require any technology. Although the claims do recite the term “on-line” in the preamble, the Examiner notes this is insufficient to overcome the rejection because the body of the claims do not depend on the preamble for completeness.

*A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.* See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

For these reasons, claims 1, 3, and 5-8 are deemed to be non-statutory subject matter.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 5, 7-9, 11, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US Patent 5,835,896) in view of Official Notice.**

Referring to claims 1, 9, and 12, Fisher teaches a system and method for conducting an on-line auction comprising: receiving a plurality of proxy bids comprising a limit price and a requested quantity (column 9, lines 18-35; Figure 3); sorting the proxy bids in an order based upon the limit prices for the proxy bids (column 9, lines 18-35); determining at least one winner of the on-line auction comprising: based on the sorted order, assigning a winning bidder designation to a first highest one of the proxy bids (column 10, lines 40-62); from the quantity of goods, allocating the requested quantity of the proxy bid of the winning bidder to the bidder (column 10, lines 40-62); after the winner determining, generating a winning sale price to assign to each of the winning bidders (column 10, lines 40-62). Fisher does not teach that the sorting is in descending order. However, Official Notice is taken that it is old and well known in the art to sort offers in descending order. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to sort the proxy bids of Fisher in descending order. One of ordinary skill in the art would have been motivated to do so in order to provide a user with the an easy way to view his or her bid in relation to all of the other bids. Fisher does not teach that when the quantity of goods is greater than zero, assigning a next winning bidder designation to the next highest one of the proxy bids and repeating the allocation of the requested quantity. However, the Examiner notes that this limitation contains the conditional statement "when" which

renders the limitation as an optional limitation because it need not be performed every time. Therefore this limitation is given little patentable weight and does not patentably distinguish the claimed invention from the prior art.

Referring to claims 3, 11, and 14, Fisher teaches determining from the sorted order a highest losing proxy bid after a last selected one of the next winning proxy bids; determining the limit price of the highest losing proxy bid; and incrementing the limit price of the highest losing proxy bid by a predetermined increment level to assign the winning sales price (column 9, lines 26-35; column 10, lines 3-28).

Referring to claim 5, Fisher teaches that a bidder associated with one of the winning proxy bids declines the allocated goods (Figure 3, column 10, lines 12-19).

Referring to claims 7 and 8, Fisher teaches that the predetermined increment level is a monetary unit of a dollar (Figure 3).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, 5-9, 11, 12, and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner  
Art Unit 3625

January 10, 2005



Y.C. Gao